REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action are respectfully requested in view of this amendment and the following reasons. By this amendment, claims 1 and 6 have been amended and claim 5 has been canceled. Claims 1-4 and 6-18 are pending in this application. The cancellation of claim 5 is made without prejudice or disclaimer to the subject matter contained therein.

Claim 1 has been amended to incorporate the features of canceled claim 5. A certain feature has been removed from claim 1, however, Applicant believes that this removal of the feature does not result in a substantial broadening of the claim scope because the feature removed from claim 1 encompasses the incorporated features from claim 5.

Claim 6 has been amended to change its dependency from canceled claim 5 to claim 1.

It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

Entry of the Amendment is proper under 37 C.F.R. §1.116 because it (a) places the application in *prima facie* condition for allowance for the reasons discussed herein; (b) does not raise new issues requiring further search and/or consideration by the Examiner because similar subject matter was previously considered by the Examiner and thus further consideration and/or search by the Examiner is not warranted; and (c) places the application in better form for appeal, should an appeal be necessary. For at least these

reasons, entry of the present Amendment is therefore respectfully requested. Accordingly, Applicant requests reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. §102

Claims 1-3 and 5-8 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,235,033 issued to Brace, *et al.* ("Brace").

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Col.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

Claim 1, as amended, recites, *inter alia*:

> ... said rigid body having ***a contact surface***, the vertebra having at one side thereof a pedicle, a superior facet with an edge, and a transverse process, said contact surface of the rigid body comprises ***a saddle surface*** configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and ***a second surface*** configured to contact simultaneously said superior facet, a first of said passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface (emphasis added).

As a preliminary matter, Applicant respectfully traverses the rejection because the cited prior art does not disclose each and every feature recited in original claim 5, which has been incorporated into claim 1 as cited above. The Examiner merely presents a conclusory statement of anticipation without elaborating how Brace teaches all of the recited features of claim 5. More specifically, in the Office Action, page 2, under the heading "Regarding Claims 5 and 7," the Examiner indicates that "Brace et al. teach a device having a saddle shaped surface and second passing holes." However, the Examiner fails to particularly point out:

> which element(s) of the device 10 disclosed in Brace teaches the vertebra "having at one side thereof a pedicle, a superior facet with an edge, and a transverse process;"
>
> which element(s) of the device 10 disclosed in Brace teaches a saddle surface "configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted;" or
>
> which element(s) of the device 10 disclosed in Brace teaches a second surface "configured to contact simultaneously said superior facet, a first of said passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface," as recited in claim 1, and similarly recited in original claim 5.

The Office Action is silent about these claim features. Thus, the Office Action fails to establish a *prima facie* case of anticipation. Accordingly, it is respectfully requested that

this final rejection be withdrawn.

Furthermore, Applicant notes that Brace *per se* does not disclose at least the above-cited claim features. In order for the structure shown in the Brace drawings to teach the above-cited features of claim 1, the surface of the device 10 must have two surfaces; one of the two surfaces, corresponding to the saddle surface, must be configured to straddle the "top of the pedicle" between the "transverse process" and the "superior facet" when the superior is mounted; the other one of the two surfaces, corresponding to the second surface, must be configured to contact simultaneously the "superior facet;" and a "first of the passing holes" must be obtained through the saddle surface and a "second of the passing holes" must be obtained through the second surface. Apparently, in any description or illustration of Brace, these features are not found.

The presently claimed subject matter makes specific reference to the shape of the contact surface of the rigid body: the contact surface comprises a saddle surface and a second surface, the saddle surface being configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and the second surface configured to contact said superior facet at the same time.

Applicant further submits that, to the extent that Brace can be said to comprise a saddle shaped surface, it is not disclosed nor obvious that the surface is shaped so that it would "straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted," as recited in claim 1. Furthermore, assuming

arguendo the surface of Brace could be considered as teaching the saddle surface of claim 1, it still does not comprise any equivalent of the second surface "configured to contact simultaneously [i.e., when the saddle surface straddles the portions of the vertebra as above] said superior facet."

Claim 1, as amended, recites a *specific geometry* of the contact surface, which is not disclosed nor suggested by Brace. Thus, Applicant respectfully submits that claim 1 is not anticipated by Brace at least because it fails to teach the above-cited features of claim 1.

Furthermore, it is respectfully noted that the term "saddle surface" can be understood in light of the specification. In this respect, Applicant respectfully disagrees with the Examiner's denial of Applicant's interpretation of the "saddle surface," on page 7 of the Office Action, because it has been maintained that limitations may be read into terms in a claim if the specification provides evidence that this should be done (*Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571-72, 7 USPQ2d 1057, 1064-1065 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); see MPEP 2145, section VI). The specification (*see* page 10, lines 19-21 of the present application as originally filed) describes the saddle surface as being "defined generally between a down-turned arch 60 and an upturned arch 62 lying in transverse planes and having a common point 64 (saddle point)." Considering the claims in view of this specification, this geometry substantially contributes to the feature that the saddle surface is "configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted." In

addition, the specification, particularly page 10, lines 18-24, relates this geometry to the shape of the pedicle, which is described as having roughly the same shape. In this regard, Applicant respectfully disagrees with the Examiner's assertion that "[s]ince a [']saddle['] can be nothing more than a generally arcuate surface, additional limitations directed to another to another arc or to hyperbolic paraboloids should not be read into the claims in the interpretation thereof," as indicated on page 7, lines 15-17 of the Office Action. Thus, Applicant submits that the descriptions from page 10, lines 18-24 of the present application are applicable to claim 1 in order to properly interpret the term "saddle surface."

Since Brace fails to teach each and every feature recited in claim 1, the reference does not anticipate the claim. Accordingly, it is respectfully submitted that claim 1, as amended, is allowable over Brace.

Claims 2, 3, and 6-8 depend directly or indirectly upon claim 1, and thus are allowable for at least this reason.

Claim 5 has been canceled without prejudice or disclaimer, thereby rendering the rejection thereto moot.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-3 and 6-8. Since none of the other prior art of record discloses or suggests all the features of the claimed subject matter, Applicant respectfully submits that independent claim 1, and all the claims that depend therefrom, are allowable.

Rejections Under 35 U.S.C. §103

1. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brace in view of U.S. Patent Application Publication No. 2003/0135210 applied for by Dixon, *et al.* ("Dixon").

Claim 4 depends from claim 1. Dixon fails to cure the deficiencies of Brace noted above with regard to claim 1 because Dixon is cited by the Examiner in an attempt to teach that "said assembly element is a threaded nut built into said rigid body," as recited in claim 4. Since neither Brace nor Dixon teaches that "said contact surface of the rigid body comprises a saddle surface configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and a second surface configured to contact simultaneously said superior facet, a first of said passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface," as recited in claim 1, even if one of ordinary skill in the art happens to combine the teachings of the two references, the combined references still do not teach these features of claim 1. Accordingly, claim 4 is allowable over Brace and Dixon, whether taken alone or in combination.

2. Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brace.

Applicant respectfully submits that claim 9 is allowable over Brace at least because it depends indirectly from claim 1, which is allowable over the same reference.

3. Claims 10-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brace in view of Dixon.

Claims 10-12 depend directly or indirectly upon claim 1. Dixon fails to cure the deficiencies of Brace noted above with regard to claim 1 because Dixon is cited by the Examiner in an attempt to teach the additional features of dependent claims 10-12. Since neither Brace nor Dixon teaches that "said contact surface of the rigid body comprises a saddle surface configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and a second surface configured to contact simultaneously said superior facet, a first of said passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface," as recited in claim 1, even if one of ordinary skill in the art happens to combine the teachings of the two references, the combined references still do not teach these features of claim 1. Accordingly, claims 10-12 are allowable over Brace and Dixon, whether taken alone or in combination.

4. Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brace in view of Dixon, in further view of U.S. Patent No. 5,665,086 issued to Itoman, *et al.* ("Itoman").

Claim 13 depends indirectly upon claim 1. Dixon and Itoman fail to cure the deficiencies of Brace noted above with regard to claim 1 because Dixon and Itoman are cited by the Examiner in an attempt to teach that "projections of said holes' axes on a

cross-section of said tubular bone intersect at an angle between 45º and 60º," as recited in claim 13. Since none of Brace, Dixon, and Itoman teaches that "said contact surface of the rigid body comprises a saddle surface configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and a second surface configured to contact simultaneously said superior facet, a first of said passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface," as recited in claim 1, even if one of ordinary skill in the art happens to combine the teachings of the three references, the combined references still do not teach these features of claim 1. Accordingly, claim 13 is allowable over Brace, Dixon, and Itoman, whether taken alone or in combination.

5. Claims 14-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brace in view of Dixon, in further view of U.S. Patent No. 5,306,275 issued to Bryan ("Bryan").

Claims 14-18 depend indirectly upon claim 1. Dixon and Bryan fail to cure the deficiencies of Brace noted above with regard to claim 1 because Dixon and Bryan are cited by the Examiner in an attempt to teach the additional features of dependent claims 14-18. Since none of Brace, Dixon, and Bryan teaches that "said contact surface of the rigid body comprises a saddle surface configured to straddle the top of the pedicle between the transverse process and the superior facet when said saddle clamp is mounted, and a second surface configured to contact simultaneously said superior facet, a first of said

passing holes being obtained through said saddle surface and a second of said passing holes being obtained through said second surface," as recited in claim 1, even if one of ordinary skill in the art happens to combine the teachings of the three references, the combined references still do not teach these features of claim 1. Accordingly, claims 14-18 are allowable over Brace, Dixon, and Bryan, whether taken alone or in combination.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 4 and 9-19. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed subject matter, Applicant respectfully submits that independent claim 1, and all the claims that depend therefrom, are allowable.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated grounds for rejection have been overcome or rendered moot. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative at the number below to expedite prosecution.

If an extension of time is necessary to prevent abandonment of this application and is not filed herewith, then such extension of time is hereby petitioned for under 37 C.F.R. §1.136(a). Any fees required for further extensions of time and any fees for the net addition of claims are hereby authorized to be charged to our Deposit Account No. 14-0112. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,
THE NATH LAW GROUP

July 21, 2009

THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314
(703)548-6284

Susanne Hopkins
Registration No. 33,247
Derek Richmond
Registration No. 45,771
Sung-Yeop Chung
Registration No. 64,130
Customer No. 20529